UNITED STATES PATENT AND TRADEMARK OFFICE

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ART UNIT	PAPER NUMBER
3623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the c ver sheet with the c rrespondence address* --

Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 October 2000</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-58</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-58</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a)☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachm nt(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Status of Claims

1.   Due to communications filed 10/26/00, the following is a non-final first office

action. Claims 1-58 are pending in this application and have been examined on the

merits. Claims 1-58 are rejected as follows.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1, 3-9, 11-21, 23-30, 32 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Saxe (US 5,636,346), and further in view of Heinly (NAHB Conferees

Explore strategies to cope with a market revolution).

As per claim 1, Saxe discloses:

Identifying, from a database of prospect lists, one or more successful lists of

prospective customers generated for the list purchaser, (Col. 12, lines 42-45, [matching

with the database to identify target subscriber listing where the subscriber represents

the customer]);

identifying, from the database of prospect lists, successful lists of prospective customers generated for each of the other list purchasers, (Col. 12, lines 48-51, [commercial information being transmitted to the subscriber], (Col. 13, lines 42-50, [where successful prospect lists are represented by the target subscriber lists that matches the customer information]); and

providing access to a targeted list of prospective customers, including at least a subset of the successful lists of prospective customers identified for the first list purchaser and for the other list purchasers, to the first list purchaser, (Col. 13, lines 37-50, [producing a target subscriber list from a subset], Col. 13, lines 60-62, [transmitting the commercial information [represents the list]).

Saxe does not specifically disclose "identifying, from the database of prospect lists, at least one other list purchaser who has used at least a subset of the one or more successful lists identified for the first list purchaser". However, Saxe would have incorporated this feature with the motivation of submitting a successfully represented list that reflects products or services that customers "would purchase" and that purchasers have previously used.

However, Heinly discloses:

identifying, from the database of prospect lists, at least one other list purchaser who has used at least a subset of the one or more successful lists identified for the first list purchaser, (Page 2, paragraph 14, lines 1-2, [maintaining a "prospect list" of former customers and of nonbuying "traffic" to target potential buyers]).

Heinly incorporated the above limitation in an analogous art for the purpose of showing that a prospect list can be determined from previous successful lists such as prospect lists of former customers.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to identify, from the database of prospect lists, at least one other list purchaser who has used at least a subset of the one or more successful lists identified for the first list purchaser with the motivation of using list purchasers to find prospect customers that would purchase certain product and services, and would be the best candidates to target.

As per claim 3, Saxe discloses:

removing duplicate prospective customers from the targeted list of prospective customers, (Col. 10, line 48, [eliminating duplicate list]).

As per claim 4, Saxe discloses:

wherein the database of prospective customers is a computer database available over a computer network via client computers to a plurality of list purchasers, (Fig. 1).

As per claim 5, Saxe discloses:

distributing the targeted list of prospective customers to the first list purchaser, (Col. 3, lines 3-13, [distributors advertising messages and accessing targeted subscribers]).

As per claims 6, Saxe discloses:

wherein the step of providing access to the first list purchaser includes

distributing the targeted list of prospective customers to a third party other than the list

purchaser,(Col. 13, lines 8-61, [shows process for third party source]).

As per claim 7, Saxe discloses:

wherein the third party contacts prospective customers on behalf of the first list

purchaser, (Col. 13, lines 63-67, [arranging for the transmission]).

As per claim 8, Saxe discloses:

wherein the third party stores the targeted list of prospective customers on a

storage medium and delivers the storage medium to the list purchaser, (Col. 4, lines 7-

14, [subscriber data stored]).

As per claim 9, Saxe discloses:

identify, from a database of prospect lists, one or more previously successful lists

of prospective customers generated for the list purchaser, (Col. 12, lines 42-45,

[matching with the database to identify target subscriber listing);

identify, from the database of prospect lists, previously successful lists of

prospective customers generated for each of the other list purchasers, (Col. 12, lines

48-51, [commercial information being transmitted to the subscriber], (Col. 13, lines 42-

50, [where successful prospect lists are represented by the target subscriber lists that

matches the customer information]);

and provide access to a targeted list of prospective customers, including at least

a subset of the successful lists of prospective customers identified for the first list

purchaser and the other list purchasers, to the first list purchaser, (Col. 13, lines 37-50,

[producing a target subscriber list from a subset], Col. 13, lines 60-62, [transmitting the commercial information [represents the list]).

Saxe does not specifically disclose "identifying, from the database of prospect lists, at least one other list purchaser who has used at least a subset of the one or more successful lists identified for the first list purchaser. However, Saxe would have incorporated this feature with the motivation of submitting a successfully represented list that reflects products or services that customers "would purchase" and that purchasers have previously used.

However, Heinly discloses:

identifying, from the database of prospect lists, at least one other list purchaser who has used at least a subset of the one or more successful lists identified for the first list purchaser, (Page 2, paragraph 14, lines 1-2, [maintaining a "prospect list" of former customers and of nonbuying "traffic" to target potential buyers]).

Heinly incorporated the above limitation in an analogous art for the purpose of showing that a prospect list can be determined from previous successful lists such as prospect lists of former customers.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to identify, from the database of prospect lists, at least one other list purchaser who has used at least a subset of the one or more successful lists identified for the first list purchaser with the motivation of using list purchasers to find prospect customers that would purchase certain product and services, and would be the best candidates to target.

As per claim 11, Saxe discloses:

remove duplicate prospective customers from the targeted list of prospective

customers, (Col. 10, line 48, [eliminating duplicate list]).

As per claim 12, Saxe discloses:

wherein the database is a computer database of prospective customers available

over a computer network via client computers to a plurality of list purchasers, (Fig. 1).

As per claim 13, Saxe discloses:

wherein the database of prospective customers is coupled to the computer over

a computer network, (Fig. 1).

As per claim 14, Saxe discloses:

a server computer hosting a prospect list service accessible via client computers

to a plurality of list purchasers, (col. 8, line 52, [file server]);

a database of prospect lists, (Col. 12, lines 32-33, [database]);

the prospect list service including a user interface comprising controls whereby a

list purchaser can access information concerning prospect lists stored in the database,

the prospect list service being available via a computer network to assist a first list

purchaser in generating and accessing a list of prospective customers, (Col. 6, lines 16-

33, [shows that the TEA Directory is accessible to the licensee, which can be an

advertising entity], Col. 16, lines 32-35, [shows means for accessing to the directory] w/

Col. 14, lines 40-44, [shows producing a target subscriber list from subscriber/customer

information in database]).

Saxe does not specifically disclose "based on previously successful lists of prospective customers generated for the first list purchaser". However, Saxe would have incorporated this feature with the motivation of submitting a successfully represented list that reflects products or services that customers "would purchase" previously.

However, Heinly discloses:

based on previously successful lists of prospective customers generated for the first list purchaser, (Page 2, paragraph 14, lines 1-2, [maintaining a "prospect list" of former customers and of nonbuying "traffic" to target potential buyers]).

Heinly incorporated the above limitation in an analogous art for the purpose of showing that a prospect list can be determined from previous successful lists such as prospect lists of former customers.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to identify, based on previously successful lists of prospective customers generated for the first list purchaser with the motivation of using list purchasers to find prospect customers that would purchase certain product and services according to list that was previously targeted and successful.

As per claim 15, Saxe discloses:

wherein the prospect list service is available via the computer network to assist a list purchaser in generating and accessing a list of prospective customers based on at least one previously successful list of prospective customers generated for a second list

purchaser other than the first list purchaser, (Col. 11, lines 41-46, [shows example

related to a second group of subscribers]).

As per claim 16, Saxe discloses:

wherein prospect list service identifies the second list purchaser based on the

second list purchaser's use of a previously successful list of the first list purchaser, (Col.

11, lines 41-46, [shows example related to a second group of subscribers]).

As per claim 17, Saxe discloses:

wherein the prospect list service identifies the second list purchaser based on

predetermined criteria relating the second list purchaser to the first list purchaser, (Col.

7, lines 5-7, [preselected criteria]).

As per claim 18, Saxe discloses:

wherein the predetermined criteria concerns a business of the first list purchaser

and the second list purchaser, (Col. 7, lines 7-9, [trading area]).

As per claim 19, Saxe discloses:

wherein the prospect list service is available via the computer network to assist a

list purchaser in generating and accessing a list of prospective customers based on at

least one list of prospective customer generated for a second list purchaser that

includes one or more prospective customers included in a previously successful list of

prospective customers generated for the first list purchaser, (Col. 11, lines 41-46,

[shows example related to a second group of subscribers]).

As per claim 20, Saxe discloses:

identifying, from a computer database containing information concerning

prospect lists available over a computer network via client computers to a plurality of list

purchasers, a second list purchaser that is related to the first list purchaser based on

predetermined criteria, (Col. 12, lines 42-45, [matching with the database to identify

target subscriber listing), w/ Col. 11, lines 41-46, [shows process can occur for a second

group of subscribers]);

identifying, from the computer database, a successful prospect list identified for

the second list purchaser, (Col. 12, lines 46-47, ([providing control signal for subscriber],

(Col. 13, lines 42-50, [where successful prospect lists are represented by the target

subscriber lists that matches the customer information]);

providing access to a targeted list of prospective customers, including one or

more prospective customers from the prospect list identified for the second list

purchaser, to the first list purchaser, (Col. 12, lines 48-51, [commercial information

being transmitted to the subscriber]);

Saxe does not specifically disclose the identification of list purchasers, however,

Saxe does disclose submitting a current customer list with "would purchase" for

products or services that are so related to the product or service to be advertised such

that the customer on those lists would most likely be considered potential customers of

the client (list purchaser) in Col. 7, lines 9-16. Since the customer list reflects products

or services that customers "would purchase", this list represents a successful list. Since

the advertiser already submits this list, the submission represents the idea that the

advertiser (list purchaser) is using this list. In this case, the client is the advertiser, represents the list purchaser, and is identified through submission of the list.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to identify list purchasers with the motivation of using list purchasers to find prospect customers that would purchase certain product and services, and would be the best candidates to target.

As per claim 21, Saxe discloses:

identifying, from the computer database, a plurality of third-party list purchasers related to the first list purchaser based on predetermined criteria, (Col. 7, lines 5-7, [preselected criteria], Col. 13, lines 8-61, [shows process for third party source]);

identifying , for the computer database, a plurality of successful prospect lists identified for one or more of the third-party list purchasers, (Col. 13, lines 42-50, [where successful prospect lists are represented by the target subscriber lists that matches the customer information]).

As per claim 23, Saxe discloses:

Removing duplicate prospective customers from the targeted list of prospective customers, (Col. 10, line 48, [eliminate duplicate list]).

As per claim 24, Saxe discloses:

Distributing the targeted list of prospective customers to the first list purchaser, (Col. 3, lines 3-13, [distributors advertising messages and accessing targeted subscribers]).

As per claim 25, Saxe discloses:

Distributing the targeted list of prospective customers to a third party other than

the first list purchaser, (Col. 13, lines 8-61, [shows process for third party source]).

As per claim 26, Saxe discloses:

wherein the third party contacts prospective customers on behalf of the first list

purchaser, (Col. 13, lines 63-67, [arranging for the transmission]).

As per claim 27, Saxe discloses:

wherein the third party stores the targeted list of prospective customers on a

storage medium and delivers the storage medium to the first list purchaser, (Col. 4, lines

7-14, [subscriber data stored]).

As per claim 28, Saxe discloses:

Wherein the predetermined criteria for identifying the second list purchaser

concerns a similar characteristic of the first list purchaser and the second list purchaser,

(Col. 11, lines 19-23, [similar characteristics]).

As per claim 29, Saxe discloses:

identify, from a computer database containing information concerning prospect

lists available over a computer network via client computers to a plurality of list

purchasers, a second list purchaser that is related to the first list purchaser based on

predetermined criteria, (Col. 12, lines 42-45, [matching with the database to identify

target subscriber listing], Col. 11, lines 19-23, [shows similar characteristics], Col. 11,

lines 41-46, [shows second group of subscribers]);

identify, from a computer database, a successful prospect list identified for the second list purchaser, (Col. 13, lines 42-50, [where successful prospect lists are represented by the target subscriber lists that matches the customer information]);

provide access to a targeted list of prospective customers, including one or more prospective customers from the prospect list identified for the second list purchaser, to the first list purchaser, (Col. 13, lines 37-50, [producing a target subscriber list from a subset], Col. 13, lines 60-62, [transmitting the commercial information [represents the list]).

Saxe does not specifically disclose the identification of list purchasers, however, Saxe does disclose submitting a current customer list with "would purchase" for products or services that are so related to the product or service to be advertised such that the customer on those lists would most likely be considered potential customers of the client (list purchaser) in Col. 7, lines 9-16. Since the customer list reflects products or services that customers "would purchase", this list represents a successful list. Since the advertiser already submits this list, the submission represents the idea that the advertiser (list purchaser) is using this list. In this case, the client is the advertiser, represents the list purchaser, and is identified through submission of the list.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to identify list purchasers with the motivation of using list purchasers to find prospect customers that would purchase certain product and services, and would be the best candidates to target.

As per claim 30, Saxe discloses:

identify, from the computer database, a plurality of third-party list purchasers related to the first list purchaser based on predetermined criteria, (Col. 7, lines 5-7, [preselected criteria], Col. 13, lines 8-61, [shows process for third party source]);

identify, from the computer database, a plurality of successful prospect lists identified for one or more of the third-party list purchasers, (Col. 13, lines 42-50, [where successful prospect lists are represented by the target subscriber lists that matches the customer information]).

As per claim 32, Saxe discloses:

Remove duplicate prospective customers from the targeted list of prospective customers, (Col. 10, line 48, [eliminate duplicate list]).

4.   Claims 2, 10, 22, 31, 36, 48, 53-58, are rejected under 35 U.S.C. 103(a) as being unpatentable over Saxe (US 5,636,346), and further in view of Heinly (NAHB Conferees Explore Strategies to Cope With a Market Revolution), and further view of Wright et al (US 6,004,276).

As per claim 2, both Saxe and Heinly fail to disclose ranking the prospect lists identified from the database based on predetermined factors to identify prospect lists most relevant to the first list purchaser. Saxe and Heinly would have included ranking the prospect list with the motivation of arranging customer requests/orders in an order that would allow the user to identify the most relevant request/order.

However Wright et al discloses:

ranking the prospect lists identified from the database based on predetermined

factors to identify prospect lists most relevant to the first list purchaser, (Col. 125, lines

43-45, [records according to hierarchy]).

Wright shows the above limitation in an analogous art for the purpose of

arranging electronic records according to uniquely identify a record to be ordered.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to rank the prospect lists identified with the motivation of

accurately associating prospect lists that accommodate specific purchasers.

As per claim 10, both Saxe and Heinly fail to disclose rank the prospect lists

identified from the database based on predetermined factors to identify prospect lists

most relevant to the first list purchaser. Saxe and Heinly would have included ranking

the prospect list with the motivation of arranging customer requests/orders in an order

that would allow the user to identify the most relevant request/order.

However Wright et al discloses:

rank the prospect lists identified from the database based on predetermined

factors to identify prospect lists most relevant to the first list purchaser, (Col. 125, lines

43-45, [records according to hierarchy]).

Wright shows the above limitation in an analogous art for the purpose of

arranging electronic records according to uniquely identify a record to be ordered.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to rank the prospect lists identified with the motivation of

accurately associating prospect lists that accommodate specific purchasers.

As per claim 22, both Saxe and Heinly fail to disclose ranking the prospect lists identified from the database based on predetermined factors to identify prospect lists most relevant to the first list purchaser. Saxe and Heinly would have included ranking the prospect list with the motivation of arranging customer requests/orders in an order that would allow the user to identify the most relevant request/order.

However Wright et al discloses:

ranking the prospect lists identified from the database based on predetermined factors to identify prospect lists most relevant to the first list purchaser, (Col. 125, lines 43-45, [records according to hierarchy]).

Wright shows the above limitation in an analogous art for the purpose of arranging electronic records according to uniquely identify a record to be ordered.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to rank the prospect lists identified with the motivation of accurately associating prospect lists that accommodate specific purchasers.

As per claim 31, both Saxe and Heinly fail to disclose rank the prospect lists identified from the database based on predetermined factors to identify prospect lists most relevant to the first list purchaser. Saxe and Heinly would have included ranking the prospect list with the motivation of arranging customer requests/orders in an order that would allow the user to identify the most relevant request/order.

However Wright et al discloses:

rank the prospect lists identified from the database based on predetermined

factors to identify prospect lists most relevant to the first list purchaser, (Col. 125, lines

43-45, [records according to hierarchy]).

Wright shows the above limitation in an analogous art for the purpose of

arranging electronic records according to uniquely identify a record to be ordered.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to rank the prospect lists identified with the motivation of

accurately associating prospect lists that accommodate specific purchasers.

As per claim 36, both Saxe and Heinly fail to disclose ranking the prospect lists

identified from the database based on predetermined factors to identify prospect lists

most relevant to the first list purchaser. Saxe and Heinly would have included ranking

the prospect list with the motivation of arranging customer requests/orders in an order

that would allow the user to identify the most relevant request/order.

However Wright et al discloses:

ranking the prospect lists identified from the database based on predetermined

factors to identify prospect lists most relevant to the first list purchaser, (Col. 125, lines

43-45, [records according to hierarchy]).

Wright shows the above limitation in an analogous art for the purpose of

arranging electronic records according to uniquely identify a record to be ordered.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to rank the prospect lists identified with the motivation of

accurately associating prospect lists that accommodate specific purchasers.

As per claim 48, both Saxe and Heinly fail to disclose rank the prospect lists identified from the database based on predetermined factors to identify prospect lists most relevant to the first list purchaser. Saxe and Heinly would have included ranking the prospect list with the motivation of arranging customer requests/orders in an order that would allow the user to identify the most relevant request/order.

However Wright et al discloses:

rank the prospect lists identified from the database based on predetermined factors to identify prospect lists most relevant to the first list purchaser, (Col. 125, lines 43-45, [records according to hierarchy]).

Wright shows the above limitation in an analogous art for the purpose of arranging electronic records according to uniquely identify a record to be ordered.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to rank the prospect lists identified with the motivation of accurately associating prospect lists that accommodate specific purchasers.

As per claim 53, Saxe discloses:

means for storing a database of prospect lists, (Col. 14, lines 29-31, [means for creating a database]);

means for providing a user interface comprising controls whereby a list purchaser can access information concerning prospect lists stored in the database, ([cable medium]);

means for generating a list of prospective customers for the first list purchaser based on previously successful lists of prospective customers generated for the first list

purchaser, (col. 14, lines 47-53, [means for controlling the transmission to target

subscribers], Col. 13, lines 42-50, [where successful prospect lists are represented by

the target subscriber lists that matches the customer information], Col. 13, lines 42-50,

[where successful prospect lists are represented by the target subscriber lists that

matches the customer information]);

Saxe fails to disclose a network interface for connecting the computer system to

a computer network, the computer system being accessible over the computer network

via client computers to a plurality of list purchasers. Saxe would have included this

limitation with the motivation of showing a means or some type of specific hardware for

providing an interface.

However Wright et al discloses:

a network interface for connecting the computer system to a computer network,

the computer system being accessible over the computer network via client computers

to a plurality of list purchasers, (Col. 29, line 65, [inter-network interface]).

Wright et al shows the above limitation in an analogous art for the purpose of

showing the specific piece of hardware used to create the interface environment.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to have a network interface for connecting the computer system to

a computer network to the computer system being accessible over the computer

network via client computers to a plurality of list purchasers with the motivation of

providing a connection point for interfacing with the internet.

As per claim 54, Saxe discloses:

means for generating a list of prospective customers for the first list purchaser

based on at least one previously successful list of prospective customers generated for

a second list purchaser other than the first list purchaser, (Col. 13, lines 42-50, [where

successful prospect lists are represented by the target subscriber lists that matches the

customer information], Col. 14, lines 47-53, [means for controlling the transmission to

target subscribers], Col. 11, lines 41-46, [shows a second group of subscribers]);

Saxe does not specifically disclose "based on previously successful lists of

prospective customers generated for the first list purchaser". However, Saxe would

have incorporated this feature with the motivation of submitting a successfully

represented list that reflects products or services that customers "would purchase"

previously.

However, Heinly discloses:

based on previously successful lists of prospective customers generated for the

first list purchaser, (Page 2, paragraph 14, lines 1-2, [maintaining a "prospect list" of

former customers and of nonbuying "traffic" to target potential buyers]).

Heinly incorporated the above limitation in an analogous art for the purpose of

showing that a prospect list can be determined from previous successful lists such as

prospect lists of former customers.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to identify, based on previously successful lists of prospective

customers generated for the first list purchaser with the motivation of using list

purchasers to find prospect customers that would purchase certain product and services

that customers "would purchase" previously.

As per claim 55, Saxe discloses:

wherein second list purchaser is identified based on the second list purchaser's

use of a previously successful list of the first list purchaser, (Col. 11, lines 41-46, [shows

example related to a second group of subscribers]).

As per claim 56, Saxe discloses:

wherein the second list purchaser is identified based on predetermined criteria

relating the second list purchaser to the first list purchaser, (Col. 7, lines 5-7,

[preselected criteria]).

As per claim 57, Saxe discloses:

wherein the predetermined criteria concerns a business of the first list purchaser

and the second list purchaser, (Col. 7, lines 7-9, [trading area]).

As per claim 58, Saxe discloses:

further comprising means for generating a list of prospective customers for the

first list purchaser based on at least one list of prospective customer generated for a

second list purchaser that includes one or more prospective customers included in a

previously successful list of prospective customers generated for the first list purchaser,

(Col. 11, lines 41-46, [shows example related to a second group of subscribers]).

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.   Claims 33-35, 37-47, 49-52, are rejected under 35 U.S.C. 102(b) as being

anticipated by Saxe (US 5,636,346).

As per claim 33, Saxe discloses:

identifying, from a computer database of prospect lists, a successful list of

prospective customers for the first list purchaser, (Col. 12, lines 42-45, [matches with

the database to identify target subscriber listing);

identifying, from the computer database, a set of additional prospect lists that

include prospective customers from the successful list of prospective customers for the

first list purchaser, (Col. 12, lines 48-51, [commercial information being transmitted to

the subscriber], (Col. 13, lines 42-50, [where successful prospect lists are represented

by the target subscriber lists that matches the customer information]); and

providing access to a targeted list of prospective customers, including one or

more prospective customers from the set of additional prospect list, to the first list

purchaser, (Col. 13, lines 37-50, [producing a target subscriber list from a subset], Col.

13, lines 60-62, [transmitting the commercial information [represents the list]).

As per claim 34, Saxe discloses:

wherein prospective customers stored in the computer database are each

assigned a unique known party ID and wherein the step of identifying a set of additional

prospect lists includes identifying prospective customers stored in the database having

the known party ID assigned to prospective customers from the successful list of the

first list purchaser, (Col. 4, line 49, [subscriber customer identification]).

As per claim 35, Saxe discloses:

identifying prospective customers stored in the database having attributes similar

to attributes of the prospective customers from the successful list of the first list

purchaser, (Col. 11, lines 19-23, [similar characteristics]).

As per claim 37, Saxe discloses:

removing duplicate prospective customers from the targeted list of prospective

customers, (Col. 10, line 48, [eliminate duplicate list]).

As per claim 38, Saxe discloses:

distributing the targeted list of prospective customers to the first list purchaser,

(Col. 3, lines 3-13, [distributors advertising messages and accessing targeted

subscribers]).

As per claim 39, Saxe discloses:

distributing the targeted list of prospective customers to a third party other than

the first list purchaser, (Col. 13, lines 8-61, [shows process for third party source]).

As per claim 40, Saxe discloses:

wherein the third party contacts prospective customers on behalf of the first list

purchaser, (Col. 13, lines 63-67, [arranging for the transmission]).

As per claim 41, Saxe discloses:

wherein the third party stores the targeted list of prospective customers on a

storage medium and delivers the storage medium to the first list purchaser, (Col. 4, lines

7-14, [subscriber data stored]).

As per claim 42, Saxe discloses:

further comprising soliciting feedback from the first list purchaser to evaluate

success of a prospect list provided to the first list purchaser, (Col. 6, lines 42-45, [shows

directory's information can come from local surveys)].

As per claim 43, Saxe discloses:

further comprising storing the feedback from the first list purchaser in the

computer database, (Col. 6, line 37, [shows survey information is updated in the

directory]).

As per claim 44, Saxe discloses:

wherein the step of identifying a successful list of prospective customers for the

first list purchaser is based on the feedback from the first list purchaser stored in the

computer database, (Col. 6, lined 49-53, [choosing targeted audience from the

directory]).

As per claim 45, Saxe discloses:

identify, from a computer database of prospect lists, a successful list of

prospective customers for the first list purchaser, (Col. 12, lines 42-45, [matching with

the database to identify target subscriber listing), w/ Col. 11, lines 41-46, [shows

process can occur for a second group of subscribers]);

identify, from the computer database, a set of additional prospect lists that

include prospective customers from the successful list of prospective customers for the

first list purchaser, (Col. 12, lines 46-47, (providing control signal for subscriber

[represents the list purchaser], (Col. 13, lines 42-50, [where successful prospect lists

are represented by the target subscriber lists that matches the customer information]);

and

provide access to a targeted list of prospective customers, including one or more

prospective customers from the set of additional prospect list, to the first list purchaser,

(Col. 12, lines 48-51, [commercial information being transmitted to the subscriber]);

As per claim 46, Saxe discloses:

wherein prospective customers stored in the computer database are each

assigned a unique known party ID and further comprising processing instructions for

directing the computer to identify prospective customers stored in the database having

the known party assigned to prospective customers from the successful list of the first

list purchaser, (Col. 4, line 49, [subscriber customer identification]).

As per claim 47, Saxe discloses:

wherein identifying a set of additional prospect lists includes

identifying prospective customers stored in the database having attributes similar

to attributes of the prospective customers from the successful list of the first list

purchaser, (Col. 11, lines 19-23, [similar characteristics]).

As per claim 49, Saxe discloses:

further comprising processing instructions for directing the computer to

removing duplicate prospective customers from the targeted list of prospective

customers, (Col. 10, line 48, [eliminate duplicate list]).

As per claim 50, Saxe discloses:

further comprising processing instructions for directing the computer to

solicit feedback from the first list purchaser to evaluate success of a prospect list

provided to the first list purchaser, (Col. 6, lines 42-45, [shows directory's information

can come from local surveys)].

As per claim 51, Saxe discloses:

further comprising processing instructions for directing the computer to

store the feedback from the first list purchaser in the computer database, (Col. 6, line

37, [shows survey information is updated in the directory]).

As per claim 52, Saxe discloses:

wherein identifying a successful list of prospective customers for the first list

purchaser is based on the feedback from the first list purchaser stored in the computer

database, (Col. 6, lined 49-53, [choosing targeted audience from the directory]).

Conclusion

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Akiba K Robinson-Boyce whose telephone number is

703-305-1340. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for

the organization where this application or proceeding is assigned are 703-746-7238

[After final communications, labeled "Box AF"], 703-746-7239 [Official Communications],

and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-305-

3900.

A. R. B.
February 17, 2004

Romain Jeanty
Primary Examiner
Art Unit 3623